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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,465	09/25/2000	Mikhail Prokopenko	169.1856	2125

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EXAMINER	
BELIVEAU, SCOTT E	

ART UNIT	PAPER NUMBER
2614	

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/668,465	PROKOPENKO ET AL.	
	Examiner	Art Unit	
	Scott Beliveau	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 February 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,4,6,9,11,12,14,17,19,20,22 and 25-78* is/are pending in the application.

4a) Of the above claim(s) *25-69* is/are withdrawn from consideration.

5)☒ Claim(s) *1,3,4,6 and 70-72* is/are allowed.

6)☒ Claim(s) *9,11,12,14,17,19,20,22 and 73-78* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07 December 2005 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 9 and 17 have been considered but are moot in view of the new ground(s) of rejection.

Election/Restrictions

3. Claims 1, 3, 4, 6, and 70-72 are allowable. The restriction requirement between groups, as set forth in the Office action mailed on 29 October 2003, has been reconsidered in view of the allowability of claims to the elected invention pursuant to MPEP § 821.04(a). **The restriction requirement is hereby withdrawn as to any claim that requires all the limitations of an allowable claim**. Claims 25-69, directed to Group II, continue to remain withdrawn from further consideration because they do not require all the limitations of an allowable generic linking claim as required by 37 CFR 1.141.

In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim(s) presented in a continuation or divisional application include all the limitations of a claim that is allowable in the present application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 9, 11, 12, 14, and 73-75 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Claim 9 sets forth a recommendation system comprising a memory means, a processing means, a searching means, and on-screen display means and claims the particular intended use of the particular elements. For claims including such excluded subject matter to be eligible, the claim must be for a practical application of the abstract idea, law of nature, or natural phenomenon. Diehr, 450 U.S. at 187, 209 USPQ at 8 ("application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection."); Benson, 409 U.S. at 71, 175 USPQ at 676 (rejecting formula claim because it "has no substantial practical application"). To satisfy section 101 requirements, the claim must be for a practical application of the Sec. 101 judicial exception, which can be identified such that the claimed invention "transforms" an

article or physical object to a different state or thing or the claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below. In the instant case the claim is not directed towards a physical transformation of matter, nor does it appear to be a practical application that produces a tangible result. The claims merely set forth a collection of parts for performing a particular operation. However, the claims do not set forth that the particular collection/combination of elements actually produce/generate/create a tangible result such as the presentation of the list of recommended items to the user resulting from operations performed by the associated means. Accordingly, claims 9, 11, 12, 14, and 73-75 are considered to be non-statutory.

6. Claims 17, 19, 20, 22, and 76-78 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter and further lacks patentable utility. Claim 17 sets forth a computer program product having a computer readable medium having a computer program recorded therein for enabling program selections. The claim further sets forth the intended usage of the computer program code. The specification sets forth that a computer readable product is a computer readable medium having software or computer programs recorded thereon (IA: Page 34, Lines 30-32) and that a computer readable medium may comprise a radio or infra-red transmission channel (IA: Page 35, Lines 22-29). A computer readable product, in light of the specification, may be construed as an electromagnetic signal. Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with

functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101. Accordingly, claims 17, 19, 20, 22, and 76-78 are not considered to be directed towards statutory subject matter.

With respect to the claim lacking utility, as aforementioned, the claims must set forth a tangible result. In the instant case, the claims are only directed towards the computer code that is intended to perform a function but is not claimed as actually generating an actual tangible result in association with the execution of that particular code.

Allowable Subject Matter

7. Claims 1, 3, 4, 6, and 70-72 are allowed.

8. The following is a statement of reasons for the indication of allowable subject matter:

The art of record either alone or in combination fails to adequately teach or suggest the claim taken as a whole and in particular the limitation of "forming sets of said attributes in response to said user selecting at least two of said programs having shared attributes, wherein each of said sets comprises at least two of said attributes". With respect to the art of record and in particular the previously applied rejection under McClard, the examiner's interpretation is that the creation of sets of attributes is formed in response to the user requesting a program recommendation as opposed to being in response to the particular intersection of attributes between programs. Accordingly, McClard fails to disclose or suggest the limitation wherein the "sets of said attributes are formed in response to that at least two of programs viewed by said user have shared attributes".

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- The Brown et al. (US Pat No. 6,973,663) reference discloses a system and apparatus for generating a listing of similar programs to those indicated in a user profile.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott Beliveau
Examiner
Art Unit 2614

SEB
March 6, 2006